



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
[www.uspto.gov](http://www.uspto.gov)

Stephen C. Glazier  
Kirkpatrick & Lockhart LLP  
1800 Massachusetts Ave., NW  
2<sup>nd</sup> Floor  
Washington, D.C. 20036

In re: Schaefer et al.  
Serial Number: 09/741008  
Filed: 21 December 2000  
Docket no.: 0272835

DECISION ON REQUEST  
FOR RETROACTIVE LICENSE  
UNDER 37 CFR 5.25

Title: Performance path method and apparatus for exchanging data among systems using different data formats

The petition is **DISMISSED** in that the petitioner's statement indicates that a license was not required.

U.S. Provisional Application 60/176,625, filed 19 January 2000, was issued a foreign license. Since the instant application and the provisional application are of the same scope of invention a retroactive license is not required (37 CFR § 5.15(c)).

Jeffrey L. Gellner  
Assistant Patent Examiner, Group 3643  
(703) 305-0053

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: SCHAEFER, et al.

Application No.: 09/741,008

Group: 3643

Filed: December 21, 2000

Examiner: Jeffrey L. Gellner

Title: PERFORMANCE PATH METHOD AND  
APPARATUS FOR EXCHANGING  
DATA AMONG SYSTEMS USING  
DIFFERENT DATA FORMATS

**RESPONSE TO DECISION ON REQUEST FOR RETROACTIVE LICENSE**  
**UNDER 37 C.F.R. 5.25**

The Honorable Commissioner of Patents and Trademarks  
Washington, DC 20231

Sir:

This response is to the Decision mailed August 12, 2002, to which a response is due within 60 days.

As the Decision requests, a copy of the application that the applicant filed in Canada on December 29, 2000 is attached hereto.

The Petition For Retroactive License filed on February 2, 2001 is now complete and in condition to be granted, and it is respectfully requested that the Petition be granted and the foreign filing license granted for '008 on March 6, 2001, be made retroactive to the filing of the enclosed Canadian application of December 29, 2000.

Note that a foreign filing license for this Application No. 09/741,008 was granted March 6, 2001 (copy attached).

Also, note that a foreign filing license for the identical material as this Application No. 09/741,008 was granted February 26, 2001, as License No. 526,460 (copy attached) regarding Serial No. P-103,749, pursuant to a Petition for Expedited Foreign Filing License requested February 22, 2001.

Further note that this application 09/741,008 was published by the U.S. Patent and Trademark Office on January 24, 2002, as Pub. No. US2002/0010867 (copy of first page attached).

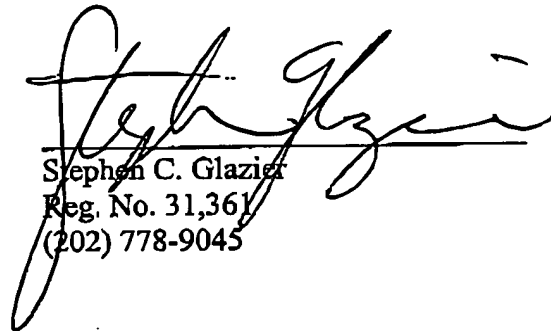
Hence, this application clearly has no secret matter to which 35 U.S.C. §181 would apply.

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Note that this application 09/74,008 is a mere modification of U.S. Provisional Application 60/176,625, which modification "do[es] not change the general nature of the invention" of the '625 application, as discussed under 35 U.S.C. §184, para. 3. A foreign filing license was granted on February 17, 2000, for the '625 application (copy attached), well before the filing of the '008 application. Therefore, pursuant to 35 U.S.C. §184, para. 3, no new foreign filing license is needed for '008, and the scope of the '625 license permits the foreign filing of '008. However, in an abundance of caution, this Petition for Retroactive License is made, and this Petition does not acknowledge or imply any such retroactive license is required.

The Commission is hereby authorized to charge any additional fees that may be required herefore, and any missing or insufficient fee filed, or asserted to be filed, which should have been filed herewith or concerning any paper filed hereafter, and which may be required now or hereafter relative to this application and the resulting official document, or credit any overpayment, to our Deposit Account 11-1110, Order No. 0307091, for which purpose a duplicate copy of this sheet is attached.

Respectfully Submitted,

  
Stephen C. Glazier  
Reg. No. 31,361  
(202) 778-9045

Date: 10 Sept 02

Kirkpatrick & Lockhart LLP  
1800 Massachusetts Ave., NW  
2nd Floor  
Washington, DC 20036  
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Attachments:

- Canadian Application Filed December 29, 2000
- Foreign Filing License for 09/741,008
- Foreign Filing License No. 526,460
- Publication No. US2002/0010867 of 09/741,008 (first page)
- Foreign Filing License for 60/176,625

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: SCHAEFER, et al.

Application No.: 09/741,008

Group: 3643

Filed: December 21, 2000

Examiner: Jeffrey L. Gellner

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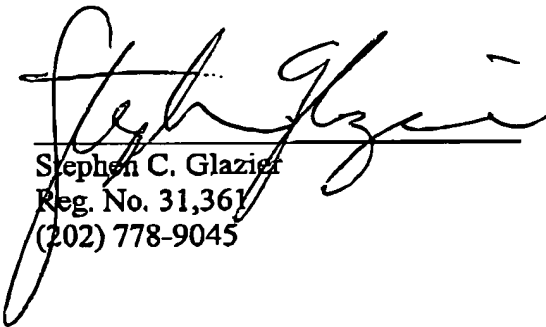
Further note that this application 09/741,008 was published by the U.S. Patent and Trademark Office on January 24, 2002, as Pub. No. US2002/0010867 (copy of first page attached).

Hence, this application clearly has no secret matter to which 35 U.S.C. §181 would apply.

Note that this application 09/74,008 is a mere modification of U.S. Provisional Application 60/176,625, which modification "do[es] not change the general nature of the invention" of the '625 application, as discussed under 35 U.S.C. §184, para. 3. A foreign filing license was granted on February 17, 2000, for the '625 application (copy attached), well before the filing of the '008 application. Therefore, pursuant to 35 U.S.C. §184, para. 3, no new foreign filing license is needed for '008, and the scope of the '625 license permits the foreign filing of '008. However, in an abundance of caution, this Petition for Retroactive License is made, and this Petition does not acknowledge or imply any such retroactive license is required.

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Respectfully Submitted,

  
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Industry Canada

Date : 2001/02/09

SMITH LYONS  
Scotia Plaza  
5800 - 40 King Street West  
TORONTO Ontario  
M5H 3Z7

## FILING CERTIFICATE

Application No. : 2,330,015 Filing Date : 2000/12/29  
Expected Laid-Open Date : 2001/07/19 Your Reference : 1199  
Priority Date : United States of America (60/176,625) 2000/01/19  
Title of Invention : PERFORMANCE PATH METHOD AND APPARATUS FOR EXCHANGING DATA AMONG  
SYSTEMS USING DIFFERENT DATA FORMATS  
Applicant(s) : REYNOLDS AND REYNOLDS HOLDINGS, INC.  
Inventor(s) : SCHAEFER, ROBERT G.; WARDHAN, HARSH

The Request for Examination and prescribed fee have been made of record.

### Special Notice

You are reminded that annual fees to maintain your application are needed for each one-year period between the 2nd and 20th anniversaries and must be paid on or before each anniversary. Failure to pay within the time limit will lead to abandonment of your application.

Commissioner of Patents

Canada

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